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09/182,825	10/29/1998	WARNER R.T. TEN KATE	PHN-16.695	2426

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EXAMINER

HONG, STEPHEN S

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 04/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/182,825

Applicant(s)

Ten Kate

Examiner

Stephen Hong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Feb 7, 2001

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-9, 11, and 13-27 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-9, 11, and 13-27 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☒ All b) ☐ Some\* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

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**Part III DETAILED ACTION**

1. This action is responsive to communications: amendment filed on February 7, 2001 and a copy of the preliminary amendment submitted on Feb 7, 2001 (originally filed on October 29, 1998) to the application, filed on 10/29/1998. The preliminary amendment was lost in the application when the first office action was mailed out. This office action addresses the preliminary amendment as well as the amendment filed on Feb. 7, 2001.
2. In the preliminary amendment claims 10 and 12 have been canceled and claims 13-21 have been added. In the amendment, claims 22-27 have been added. Accordingly, claims 1-9, 11 and 13-27 are pending in the case. Claims 1, 9, 11, 13, 14 and 22 are independent claims.
3. The rejection of claims 10 and 12 under 35 U.S.C. § 112, second paragraph, as being indefinite has been withdrawn as the claims have been canceled.

***Priority***

4. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119, which papers have been placed of record in the file.

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***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 9, 11, 14, 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 1, 9, 11, 14, 22, the claimed feature of "...the sub-presentation is provided with an interface providing a reference for the play-out specification of the presentation element, wherein the reference is defined independent of the coded presentation" is vague and indefinite. It is unclear what is meant by the phrase "wherein the reference is defined independent of the coded presentation."

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-9, 11 and 13-27 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

The claims are not directed to statutory subject matter because the claimed subject matter:

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- (1) does not fall within one of the four statutory classes of inventions under § 101;  
and/or
- (2) falls within the mere idea or abstract intellectual concept exception to § 101;  
and/or
- (3) falls, by analogy, within the printed matter exception to § 101.

The claimed "data structure" is non-functional data structure which is considered non-statutory subject matter by analogy to the "printed matter" exception under § 101. See In re Miller, 164 USPQ 46, 49 (CCPA 1969). Like printed matter, a data structure, in and of itself, is merely an arrangement of data and nothing more. Furthermore, claims drawn to printed matter may be non-statutory even though the claims recite the structure on which the printed matter is printed:

The *mere arrangement* of printed matter on a sheet or sheets of paper, in book form or otherwise, does not constitute "any new and useful art, machine, manufacture, or composition of matter," or "any new and useful improvements thereof," as provided in section 4886, of the Revised Statutes [the predecessor to 35 U.S.C. § 101].

(emphasis in original). In re Russell, 9 USPQ 181, 182 (CCPA 1931). At best, the claims as a whole describe a data structure stored in a computer system. Accordingly, like printed matter "stored" on a sheet of paper, a data structure stored in a computer system fails to present statutory subject matter.

The claims recite the limitations directed to describing attributes of the "coded presentation", "sub-presentation", etc. These representations are merely the descriptions of

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multimedia data, which are “non functional” data structures . The claims do not recite any limitations of “manipulating” the data structures to achieve “practical application.” Therefore, the claimed recitations of describing these representations are merely “non functional” data structures, which are not statutory.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371<sup>9</sup> of this title before the invention thereof by the applicant for patent.

10. Claims 1-6, 8, 9, 11, 13-19, 21-25 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Moorby et al., U.S. Pat. No. 5,892,507, 4/99 (filed on 4/6/95).

As per Claims 1-6, Moorby teaches the use of a sub-presentation which comprises a plurality of sequence of presentation (FIG.11a-11c), wherein the sequence of presentation are presented one after the other, and simultaneously with respect to each other (FIG.12a; col.12, lines 7-35), wherein the start and duration are also specified (col.11, lines 45-55, “...the length of a TimeLine track and the Icons along it depict the duration...”), and further shows that the interface of the sub-presentation provides a time references (see FIG.12b).

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As per dependent claim 8, Moorby teaches that the sub-presentation provides a sub-presentation priority specifying a priority with respect to presenting the subpresentation (FIG. 1 shows the priority direction of the sub-presentations along the storyline).

Claims 9, 11 and 13 recite substantially similar limitations as Claim 1 and are similarly rejected under the same rationale.

Claims 14-19 and 21 recite substantially similar limitations as claims 1-6, 8, respectively, and are rejected under the same rationale.

Claims 22 recites substantially similar limitations as claims 1 and 2, combined and claims 23-25 and 27 recite substantially similar limitations as claims 4-6 and 8, respectively, and are rejected under the same rationale.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103<sup>©</sup> and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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12. Claims 7, 20 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moorby et al. in view of Gudmundson et al., U.S. Pat. No 5,680,619, 10/97 (filed 4/95).

As per dependent claim 7, Moorby does not explicitly teach that the play-out specification includes a location specification specifying a location of the presentation element when presented and wherein interface of the sub-presentation provides a location frame of reference relative to which the location specification for the presentation element is specified. This feature, however, is shown by Gudmundson. Like, Moorby, Gudmundson also teaches authoring the multimedia presentation using the sub-presentation groups, called "containers"(col.8, lines 25-67). Note that within a container includes the sequence of presentations, and also contains the location attributes (e.g., FIG.16(c)) , all of which are interfaced by the container's object interface (col.16, lines 53+). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have incorporated Gudmundson's feature into Moorby, since a person of ordinary skill would have appreciated that would have provide a user of the Moorby's editor the ability to edit the layout information in addition to the timing information.

Claims 20 and 26 recite substantially similar limitations as claim 7 and are rejected under the same rationale.



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*Response to Arguments*

13. Applicant's arguments filed Feb. 7, 2001 have been fully considered but they are not persuasive.

Applicant on page 7 of the argument asserts that the prior art of Moorby does not disclose or suggest the feature of "...the sub-presentation is provided with an interface providing a reference for the play-out specification of the presentation element, wherein the reference is defined independent of the coded presentation." However, Applicant does not explain what this phrase means. On page 7, the same phrase is repeated twice while alleging that the reference of Moorby lacks it, but no explanation is given as to what this can be. As rejected under 35 USC 112, second paragraph above, the limitation simply is unclear as to what is being claimed.

*Conclusion*

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday-Friday from 8:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

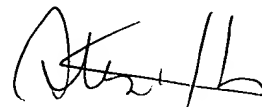
**or faxed to:**

(703) 308-9051, (for formal communications intended for entry)

**Or:**

(703) 305-9724 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).



Stephen Hong

Primary Examiner

April 21, 2002